



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/829,600 | 04/09/2001 | Steven E. Barile | 42390P9913 | 7945 |

7590

04/28/2003

Charles A. Mirho
BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN, LLP
7th Floor
12400 Wilshire Boulevard
Los Angeles, CA 90025

EXAMINER

ALAUBAIDI, HAYTHIM J

ART UNIT

PAPER NUMBER

2171

DATE MAILED: 04/28/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/829,600

Applicant(s)

BARILE ET AL.

Examiner

Haythim J. Alaubaidi

Art Unit

2171

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 April 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 April 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. Claims 1-26, are presented for examination.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-5, 7-19 and 21-25, are rejected under 35 U.S.C. 103(a) as being unpatentable over Harry W. Morris (U.S. Patent No. 6,496,851 and Morris hereinafter).

Regarding Claims 1-2, 8-9, 15-16 and 21-22 Morris discloses"

receiving a dedication¹ from a first user (Figure No. 3, Element No. 301; see also Col 3, Lines 47-50, i.e. *A protocol, referred to as the "Rendezvous" protocol, is designed to facilitate interactions between users of a computer network by transmitting a first user's proposal for an activity to another user*, see also Col 8, Line 18)

Morris reference discloses the claimed subject matter set forth above, except it does not explicitly indicate the applying of the dedication to a play list of a second user feature. However the reference does teach applying instant messages to an applet that

¹ The "dedication" is being interpreted to be for example like a request to chat with a second user or a request to transfer a file to a second user or even a request to play a game with a second user.

Art Unit: 2171

could be considered as a play list² (Figure No. 2³; see also Figure NO's 10 and 11; see also Col 5, Lines 58-59, i.e. *send IMs back and forth, and transfer files*). Given the intended broad application of the Morris system, it would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to modify the teachings of Morris by using the chat rooms as play lists, one way to do this is through the use of audio or voice in the chat room (play list) as it was indicated by Morris (Col 4, Lines 24-25); another reason why a "play list" could be interpreted as an applet of a chat room is due to the capability of playing games through these chat rooms (play list), see Col 4, Line 25, i.e. play an online game; another reason would be by interpreting the "file transfer capability" mentioned in Morris Col 4, Line 26 to actually use an audio or video file (like it is mentioned in the instant application in Claim 3 and 4).

Regarding Claims 3-4, Morris discloses audio and/or video (Col 9, Lines 58-64).

Regarding Claims 5, Morris discloses text messages (Figure No. 11).

Regarding Claims 7, Morris discloses wherein the first and second users are online (Col 5, Lines 17-23).

² The "play list" in the instant application can be interpreted to be the applet where the users are chatting or even playing a game (see Figure No. 2), please see Col 4, Lines 24-28, i.e. Typical activities include exchanging voice messages, playing an online game, finding a route from one client computer to another, transferring files, direct instant messaging, exchanging avatars, participating in a chat room, or engaging in collaborative project development.

³ The Element No. 204 is showing different users chatting with each other, which in other words, the system is applying the chat message or the text or the voice or even a transfer file (dedicating) to the applet (play list).

4. Claims 6, 20 and 26, are rejected under 35 U.S.C. 103(a) as being unpatentable over Harry W. Morris (U.S. Patent No. 6,496,851 and Morris hereinafter) in view of Stephen Sutton (U.S. Patent No. 6,539,354 and Sutton hereinafter).

Regarding Claims 6, 20 and 26, Morris reference discloses the claimed subject matter set forth above, except it does not explicitly indicate the step of converting text to audio. However Sutton discloses converting text to audio (Col 3, Lines 34-35, i.e. *the text-only input is converted into a synthesized audio and visual speech output*)⁴. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to modify the teachings of Morris with the teachings of Sutton to include such a well known software in order to increase the flexibility of the system and also to make it more user friendly; another reason would be to increase the amount of users who can actually make use of the system, such as the visually challenged people.

Other Prior Art Made of Record

5. a. Takahisa et al. (U.S. Patent No. 5,577,266) discloses a broadcast system with associated data capabilities.

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure.

⁴ The Examiner would like to direct the Applicant's attention to the fact that this converting feature is well known in the art, including the Patent No. 6,448,485 awarded to the same inventor and the same assignee of the current Application.

Points of Contact

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Haythim J. Alaubaidi whose telephone number is (703) 305-1950. The examiner can normally be reached on Monday - Friday from 8:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic, can be reached on (703) 308-1436.

Any response to this office action should be mailed to:

The Commissioner of Patents and Trademarks, Washington, D.C. 20231 or telefax at our fax number (703) 746-7238 or (703) 746-7239 or (703) 746-7240.

Hand-delivered response should be brought to Crystal Park II, 2121 Crystal Drive, 6th Floor Receptionist, Arlington, Virginia. 22202.

Haythim J. Alaubaidi

Haythim J. Alaubaidi
Patent Examiner
Technology Center 2100
April 18, 2003


SAFET METJAHIC
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100